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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------------|------------------|
| 09/966,309 | 09/28/2001 | Dirk Kranendonk | 25098A | 5049 |
| 22889 | 7590 | 05/26/2005 | EXAMINER | |
| OWENS CORNING 2790 COLUMBUS ROAD GRANVILLE, OH 43023 | | | TORRES VELAZQUEZ, NORCA LIZ | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1771 | |
| DATE MAILED: 05/26/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/966,309

Applicant(s)

KRANENDONK, DIRK

Examiner

Norca L. Torres-Velazquez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 22-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 22-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed March 08, 2005 have been fully considered but they are not persuasive.

- a. Applicants have amended independent claim 1 to further recite the limitation "*said regular, roller paintable surface being substantially free of random discontinuities susceptible to creating visible irregularities when roller painted*". It is noted that there is no expressed support in the specification for such limitation. Therefore, the new limitations in the claim are considered new matter.

- b. It is noted that the Specification of the present invention discloses that the polymeric coating covers the surface of the mat, thereby reducing *the porosity of the mat* significantly. Further, it describes that the polymeric material also has a degree of gas permeability to allow moisture to escape from underneath. [0006] Applicants argue that the term "regular" surface should be interpreted as "even", "smooth" or "uniform", rather than "normal". Applicants indicate that the Jackson reference discloses a material having a surface with intentionally formed "randomly distributed discontinuities" and argue that these discontinuities are disadvantageous from the standpoint that they would more readily receive any paint roller-applied to the surface and magnify its imperfect, or "irregular" nature.

It is noted that the Jackson reference provides a breathable or moisture permeable wallcovering having a porous polymeric ply, which is fused to and supported by a nonwoven substrate ply. The porous polymeric ply as a smooth, continuous aesthetically pleasing appearance, while simultaneously achieving a moisture vapor permeability

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which prevents moisture from being trapped on or within a wall to which the wall covering is applied. More specifically, the porous polymeric ply has a substantially macroscopic-continuity wherein a plurality or multiplicity of miniature or microscopic discontinuities or holes are randomly distributed. (Col. 2, lines 19-32) It is the Examiner's interpretation that the now claimed "random discontinuities" are macroscopic discontinuities that would be visible to the unaided eye which are different from the microscopic discontinuities of the Jackson reference. As noted above, polymeric material of the present invention also has a degree of gas permeability to allow moisture to escape from underneath, therefore, it is the Examiner's position that microscopic discontinuities such as those of Jackson would be recognized in the present invention since both reference are directed to provide a polymeric material coating that provides gas permeability. The rejections over JACKSON are maintained herein since the microscopic discontinuities of the polymeric material of the reference do not affect the continuity or smoothness of its outer or exposed surface when looked by the unaided eye. (Jackson, Col. 2, lines 32-34) Therefore, "visible irregularities" would not be created when roller painted since the discontinuities in the polymeric material are microscopic and are not visible by the unaided eye.

The burden is shifted to Applicants to show that the structure of Jackson is different to the present invention.

2. Applicant's arguments, see page 13 of arguments, filed March 8, 2005, with respect to the Gundberg et al. (US 6,203,646 B1) reference have been fully considered and are persuasive. The rejection of claims 1-6, 9-10 and 13 has been withdrawn. The rejection is withdrawn from the premise that the "regular" surface claimed herein is an "even" or

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“smooth” surface when looked by the unaided eye, and the netting having the appearance of the underlying nonwoven material as taught by Gunberg will teach away from that.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-13 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants have amended independent claim 1 to further recite the limitation “*said regular, roller paintable surface being substantially free of random discontinuities susceptible to creating visible irregularities when roller painted*”. It is noted that there is no expressed support in the specification for such limitation.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention as stated in previous action.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1, 3-5, 9-12 and 22-27, 31-35 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by JACKSON (US 5,876,551) and further evidenced by WO 95/07946 (Abstract).

JACKSON teaches a breathable, decorative wall-covering having a smooth, continuous, aesthetically appealing exposed surface which can be printed with a design or pattern having sharply defined edges, and having a relatively high moisture permeability. The wall covering includes a porous polymeric ply fused to a nonwoven substrate ply. The porous polymeric ply is formed by thermally fusing a plastisol coating. The plastisol coating is thick enough to allow the formation of a coating, which upon thermal fusion provides a polymeric ply having a smooth continuous appearance. Upon heating the plastisol coating to a temperature, which is sufficient to cause fusion of resins contained therein, a highly permeable polymeric ply having the

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appearance of smooth, continuous film is formed. (Abstract) The reference further teaches that suitable resins used in the plastisols generally include a variety of thermoplastic resins, which are capable of fusing and absorbing the plasticizer upon application of heat. (Column 4, lines 62-67) It is noted that the use of resins such as polyethylene in plastisol to produce a coating material is known in the art as evidenced by the abstract of WO 95/07946. Further, JACKSON teaches the incorporation of titanium oxide, among other components, in the plastisol. (Column 5, lines 27-37) It is noted that the plastisol described by JACKSON is a dispersion. With regards to claim 22 and 34, JACKSON further teaches that the plastisol coating is preferably applied at a coating weight of from about 47 grams per square meter to about 155 grams per square meter. (Column 5, lines 52-57) With regards to claims 11 and 12, JACKSON teaches the use of mineral fibers in the nonwoven and also teaches that the area weight of the nonwoven is from about 47 gsm to about 61 gsm). (Column 4, lines 32 and lines 59-61) JACKSON also teaches that the two ply composite wall covering generally have a moisture permeability of from about 25 perms to about 50 perms. (Column 6, lines 42-44)

It is the Examiner's interpretation that the plastisol taught by JACKSON will read on the presently claimed thermoplastic polymer coating since the plastisol contains thermoplastic resins in a dispersion. The nonwoven substrate ply is equated to the presently claimed nonwoven fiber tissue or mat.

Claim Rejections - 35 USC § 102/103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 2, 8 and 30 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JACKSON et al.

JACKSON et al. is silent with respect to the claimed surface tension of the coating surface and the water transmission rate. However, it is reasonable to presume that the claimed properties are inherent to the invention of JACKSON et al. Support for said presumption is found in the use of the same starting materials (i.e. fiber matt and thermoplastic polymer coating), like processes of making the articles (i.e., melting polymer of the matt), and the production of similar end-products (i.e., reinforced mineral fiber materials, etc...). The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the presently claimed function of surface tension and water transmission rate would obviously have been provided as a result of the product of the JACKSON et al. reference. *Note In re Best*, 195 USPQ 433.

Claim Rejections - 35 USC § 103

10. Claims 6-7 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over JACKSON as applied above, and further in view of PENZ et al. (US 5,888,913).

PENZ et al. discloses glass matt reinforced thermoplastic and one of the object of their invention is to find glass matt reinforced thermoplastics with no insert visibility and that on the painted part satisfactory paint adhesion on the glass matt reinforcement thermoplastic surface is obtained without great expenditure. The reference teaches the addition of fine-particle, mineral fillers to enhance the paint adhesion. (Column 1, lines 64 – Column 2, lines 1-10)

The reference further teaches adding mineral fillers such as *talc*, chalk and barium sulfate at concentrations from 2 to 60% by weight to the thermoplastics. (Column 3, lines 14-18)

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Since both JACKSON et al. and PENZ et al. are from the same field of endeavor, the purpose disclosed by PENZ et al. would have been recognized in the pertinent art of JACKSON et al.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the thermoplastic polymer coating and provide it with mineral fillers with the motivation of obtaining a satisfactory paint adhesion on the glass matt reinforced thermoplastics as disclosed by GUNBERG et al. (Above).

11. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over JACKSON as applied above, and further in view of MELBER et al. (US 4,898,892).

MELBER et al. discloses a method for making an opaque coating comprising combining a film forming coating binder and a composite opacifier. The reference teaches the use of inorganic opacifier materials such as titanium dioxide and calcium carbonate. (Column 1, lines 36-45) On Table III, the reference teaches how the film thickness and volume of opacifier is necessary for 94% hiding. (Column 17, lines 6-23). With regards to claim 13, the claimed composition for the coating is known under the trademark product Papermatch as a dispersion of ground calcium carbonate and ground titanium dioxide in high density polyethylene and the prior art of reference teaches the use of these components, the ratio or ranges of concentration of these would be an obvious cause-effective variable that will depend on the intended refractive index of the opacifying component. (Refer to claims 1 and 3)

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the coating material to contain titanium dioxide with the motivation of providing the coating with "hiding" as disclosed by MELBER et al. (Above and also refer to column 2, lines 24-26).

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12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Norca L. Torres-Velazquez whose telephone number is 571-272-1484. The examiner can normally be reached on Monday-Thursday 8:00-5:00 pm and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Norca L. Torres-Velazquez
Examiner
Art Unit 1771



NORCA TORRES
PRIMARY EXAMINER

May 19, 2005